

## REMARKS

Claims 1, 10 and 14 have been amended. Applicants reserve the right to pursue the original claims and other claims in this application and other applications. Claims 1-3 and 9-14 are pending in this application.

The Examiner has requested that the application data in paragraph number 49 on page 16 be updated with the current status of the application. There are currently no updates to this application, as it is still pending.

Claims 1-3 and 9-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (U.S. 6,005,945) in view of Brasington et al. (EP 0893787 A2 or U.S. 5,293,406) as evidenced by either Shah et al. (U.S. 5,822,738 or 2003/0078893). Reconsideration is respectfully requested.

A problem with conventional virtual metering is that customers, i.e., mailers, using a virtual postage metering system to evidence postage on mail have to obtain a meter license for a meter account with a dedicated origin zip code. This meant the mailer had to go through a registration process with the United States Post Office (USPS) and wait for approval from the USPS for a meter license before the mailer was allowed to print postage obtained over the Internet. This delay, due to the mailer having to wait for approval for a meter license from the USPS before being able to print postage from a PC, can act as a deterrent to mailers to utilize PC postage. (Specification, paragraphs [0009] and [0023]).

The present invention alleviates the problems of the prior art by providing a system and method that allows instant metering of online postage. In accordance with the present invention, a mailer can print postage using a personal computer without having a meter license or meter account. In one embodiment, a meter account is licensed to a vendor (and not the individual mailer) for dispensing postage to customers from a plurality of origin zip codes. A vendor meter account 50 is located at a remote Data Center 30. The meter account 50, which is assigned to the

vendor, dispenses postage payment evidence to a plurality of customers 25. (Specification, paragraph [0031]).

In view of the above, claim 1 recites a method for a vendor to dispense postage over a network to a remote personal computer that comprises "obtaining a meter license from the Post, said meter license being associated with a meter account assigned to the vendor; receiving, via the network, a transaction request for postage from a customer using the remote personal computer, said transaction request including information from the customer, said information corresponding to the transaction requested and payment method; processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor; effecting payment for the transaction based on the information received from the customer; receiving the evidence of postage payment created by the data center; and sending the evidence of postage payment to the remote personal computer for use by the customer." Thus, a mailer can print postage without having a meter license or meter account assigned to the mailer, but instead utilizes a meter account assigned to the vendor.

As noted in the Office Action, there is no disclosure, teaching or suggestion in Whitehouse of a "meter license being associated with a meter account assigned to the vendor" as is recited in claim 1. Furthermore, there is no disclosure, teaching or suggestion in Whitehouse of dispensing postage in response to a transaction request received by a vendor over a network from a customer that includes "processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor" as is recited in claim 1.

To overcome these deficiencies, the Office Action relies on the references to Brasington et al. and concludes that it would have been obvious to one of ordinary skill at the time the invention was made that the postage metering system of Whitehouse could be modified to sell postage directly to users without requiring the

user to obtain a postage metering license as taught by Brasington et al. Applicants respectfully disagree.

Applicants wish to note that Brasington et al. EP 0893787 is identical to and claims priority from Brasington et al. US 5,923,406. All column and line references included herein are specifically to Brasington et al. EP 0893787, but also apply to Brasington et al. US 5,923,406. Brasington et al. is directed to a vending machine system capable of printing personalized postage stamps including a picture of an individual. The vending machine 1 can be located anywhere such as in convenience stores, malls, etc. so that any consumer can simply walk up to the vending machine to obtain personalized postage stamps. The vending machine 1 includes a base portion 3 that supports an upper enclosed portion 5 within which all of the operating components of the vending machine 1 are securely housed. (Col. 3, lines 20-29). The personalized postage stamp, printed by an ink jet printer 39 under the control of the microcontroller 31 of the vending machine 1, includes an image 69 of the consumer taken by a digital camera 13. The image 69 is printed in conjunction with other conventional postage stamp data required by the postal authority to create the personalized postage stamp 2. The other data can include encrypted vendor and digital tokens 83, 85 that are used as a means for verifying the authenticity of the printed personalized postage stamp 2 to provide the postal authority with the capability of detecting fraudulently produced stamps. The programming, algorithms and keys for generating the digital tokens 83, 85 are stored in memory 35 of the vending machine 1. Additionally, the postage stamp image generation engine is included as part of the microprocessor 31. (Col. 6, lines 10-50).

Note first that the purchasing of stamps from a kiosk is completely different than utilizing a personal computer (PC) based metering system. The PC based metering system allows users to print postage from a PC via a network. The PC can be located at the users office, home, etc. In a virtual metering network, the accounting and generation of an indicium is done at a data center located remotely from the PC. This allows a user to print postage without having any type of specialized equipment installed at the PC. In the kiosk environment, in contrast, the

user must first locate a vending machine (in a convenience store, mall, etc.). The generation of an indicium is done locally at the vending machine (the programming, algorithms and keys for generating the digital tokens 83, 85 are stored in the memory 35 of the vending machine 1). The vending machine is, in fact, similar to a traditional closed system postage meter. The system in Brasington et al. would not allow a user to quickly and easily obtain postage over a network. The infrastructure, security requirements, and theory of operation for a vending machine that dispenses postage and a virtual metering network are different and in many instances incompatible. It is not possible to simply replace one system with the other, or to randomly pick, choose and replace different components from one system to another. Thus, by attempting to incorporate the closed system meter found in Brasington et al. with any of the other references directed to a PC based metering system would significantly change the principle of operation of the PC based metering systems. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office Action further relies on the references to Shah et al. to show that a single secure metering device or accounting unit can be used by a number of different users connected to a network. The Office Action fails to consider, however, that in both references to Shah et al., in order to utilize the secure metering device or accounting unit, the user must first obtain a required license or meter account from the postal service. There is no disclosure, teaching or suggestion in either Shah et al. of a "meter license being associated with a meter account assigned to the vendor" as is recited in claim 1. Furthermore, there is no disclosure, teaching or suggestion in either Shah et al. of dispensing postage in response to a transaction request received by a vendor over a network from a customer that includes "processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor" as is recited in claim 1.

The fact that the present invention was made by the Applicants does not make the present invention obvious; that suggestion or teaching must come from the prior art. See *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so). The Office Action contends that the postage metering system of Brasington et al. makes it easier for a user to obtain postage, since the user does not need to obtain a postage metering license to obtain postage from the licensed vendor or operator of kiosk 1. The Office Action fails to consider, however, that the user must still go to the location at which the vending machine is located to purchase the postage. This is no different than a user having to go to the post office to purchase conventional stamps. The user does not need to obtain a postage metering license to obtain conventional postage stamps, either. The user, however, must still physically go to the post office (or any other location where stamps are sold) to purchase the stamps. This is clearly not easier than being able to print postage directly from a personal computer, located at the user's office, home, etc., as the user does not need to physically go to a location where the vending machine is located to purchase postage. As noted above, the present invention provides a system and method that allows instant metering of online postage. In accordance with the present invention, a mailer can print postage utilizing a personal computer without having a meter license or meter account.

"Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in a way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed. Cir. 1998) (emphasis added). As noted above the system of Brasington et al. is very different from and incompatible with a PC metering

system, and does not make it easier for a user to obtain postage. There is simply no suggestion or motivation to modify the postage metering systems of Whitehouse, Brasington or either Shah et al. to sell postage to users without requiring the user to obtain a postage metering license.

Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from these references. The rejection uses impermissible hindsight to reconstruct the present invention from these references. See *Ex parte Clapp*, 227 U.S.P.Q. 972,973 (Bd. App. 1985) (requiring "convincing line of reasoning" to support an obviousness determination).

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this case are in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,



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